

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

BANOM, INC.,

Plaintiff,

v.

DIRECT TOOLS & FASTENERS, INC.,

Defendant.

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CIVIL ACTION NO.

COMPLAINT

Plaintiff, Banom, Inc., for its Complaint against Defendant, Direct Tools & Fasteners, Inc., alleges as follows:

1. This is an action involving claims for trademark infringement, unfair competition and false designation of origin, arising under the Federal Trademark Act of 1946, as amended, 15 U.S.C. §§ 1051 et seq., the common law of the Commonwealth of Pennsylvania, and for copyright infringement under the United States Copyright Act of 1976, as amended, 17 U.S.C. §§ 101 et seq.

THE PARTIES

2. Plaintiff, Banom, Inc. (hereinafter "Banom"), is a corporation of the Commonwealth of Pennsylvania, having its principal place of business at 3013 Phoenixville Pike, Malvern, Pennsylvania 19355.

3. Defendant, Direct Tools & Fasteners, Inc. (hereinafter "Direct Tools"), is a corporation of the State of California, having its principal place of business at 1000 N Lake Street, Burbank, California 91502.

JURISDICTION

4. This Court has jurisdiction over this matter pursuant to 15 U.S.C. § 1121, 17 U.S.C. §§ 101 et seq. and 28 U.S.C. §§ 1331, 1332(a), 1338(a) and (b) and 1367(a).

STATEMENT OF FACTS

5. Banom is in the business of designing, developing and selling protective gloves, sleeves and garments for industrial use. Banom has been in business since 1987.

6. Among the products sold by Banom are cut-resistant gloves for industrial use. One of Banom's trademarks applied to these gloves is TERMINATOR.

7. As a result of substantial promotion and sales of gloves under the trademark TERMINATOR, said trademark has become unique and is identified by the purchasing public solely with Banom. The trademark TERMINATOR is a valuable asset of Banom, and its reputation and goodwill. The TERMINATOR gloves are the top-selling brand of Banom.

8. Banom has duly registered its trademark TERMINATOR, for use on cut-resistant gloves for industrial use, in the United States Patent and Trademark Office, under Certificate of Registration No. 2,748,280. The Certificate of Registration is now incontestable, has been renewed and is alive. A copy of the Certificate of Registration is attached as Exhibit A.

9. It has recently come to Banom's attention that Direct Tools is offering for sale and selling gloves identified as Banom TERMINATOR gloves. Attached as Exhibits B and C are two pages from Direct Tool's website, offering Banom's TERMINATOR gloves for sale.

10. On December 29, 2016, an order was placed with Direct Tools for six pairs of TERMINATOR gloves, size 9. A confirmation of the order from Direct Tools is

attached as Exhibit D. To protect the privacy of the purchaser, the personal information of the purchaser has been redacted.

11. The gloves delivered pursuant to the order of Exhibit D were not TERMINATOR gloves. The gloves were delivered in a transparent plastic sleeve, with the trademark TERMINATOR handwritten in black marker on the sleeve. A copy of the sleeve with the delivered gloves is attached as Exhibit E.

12. The gloves within the transparent plastic sleeves carry the trademark X-Grip. A copy of the gloves is attached as Exhibit F.

13. The X-Grip gloves are not a product of Banom.

14. Banom has never sold TERMINATOR gloves to Direct Tools. Banom has never sold any of its other products to Direct Tools.

15. In 2010, Banom published a catalog for its cut-resistant gloves. The copyright in the catalog was duly registered under Certificate of Registration No. TX 7-273-448. A copy of the cover of the catalog is attached as Exhibit G. A copy of the copyright Certificate of Registration for the catalog is attached as Exhibit H.

16. The catalog shown in Exhibit G contained original photography created by Banom. Attached as Exhibit I is a copy of the catalog page containing a photograph of the front and rear of the TERMINATOR gloves.

17. The photograph of the TERMINATOR gloves appearing in Exhibit I also appeared on Banom's website.

18. Direct Tools copied the photograph of Exhibit I to depict the photograph on Direct Tools' website (Exhibits B and C).

19. On information and belief, the copying of the photograph of Exhibit I by Direct Tools was from the photograph that appeared on Banom's website

20. Direct Tools offered cut-resistant gloves for sale under the trademark TERMINATOR to trade on the goodwill that Banom had developed in its trademark, with the intention to deliver gloves other than Banom's TERMINATOR gloves, all to the damage of Banom.

21. Direct Tools used Banom's copyrighted photograph of its TERMINATOR gloves in order to trade on the goodwill that Banom had developed in its trademark, with the intention to deliver gloves other than Banom's TERMINATOR gloves, all to the damage of Banom.

#### COUNT I

##### STATUTORY TRADEMARK INFRINGEMENT

22. Direct Tools' placing of the trademark TERMINATOR on the packaging for gloves which were not TERMINATOR gloves and were not purchased from Banom, and promoting the gloves as being Banom's TERMINATOR gloves led customers to believe that the gloves were sold, authorized or sponsored by Banom.

23. Direct Tools used the trademark TERMINATOR with the intention of deceiving the public and to confuse the public as to the origin of its gloves.

24. The use and advertising of the trademark TERMINATOR by Direct Tools is an infringement on Banom's registered trademark TERMINATOR, covered by Certificate of Registration No. 2,748,280, in connection with the sale, offering for sale, distribution and advertising of its gloves, and such use is likely to cause confusion, or to cause mistake or to deceive.

25. The foregoing acts of Direct Tools constitute trademark infringement by Direct Tools, and they were willful, and caused or were intended to cause irreparable harm to Banom.

26. The foregoing infringing acts of Direct Tools are a violation of Banom's rights under 15 U.S.C. §1114(1).

## COUNT II

### UNFAIR COMPETITION

27. The use by Direct Tools of the trademark TERMINATOR in connection with the sale, offering for sale, distribution or promotion of the gloves of another manufacturer was done with the intention of palming off its gloves as being those of Banom, or as being sponsored, licensed or otherwise approved or authorized by Banom.

28. The use of the name, trademark and photograph of Banom's TERMINATOR gloves by Direct Tools, and then delivering the gloves of another manufacturer, bearing a different trademark, was a successful attempt by Direct Tools to palm off the gloves of another as being those of Banom sold under the registered trademark TERMINATOR.

29. The foregoing acts, as set forth in Paragraphs 27 and 28, unfairly compete with Banom.

## COUNT III

### FALSE DESIGNATION OF ORIGIN

30. The use and promotion of the trademark TERMINATOR by Direct Tools, in commerce, in the manner described above constitutes a false designation of origin within the meaning of 15 U.S.C. § 1125(a), which is likely to cause confusion, mistake or deception as

to the source, origin, sponsorship and/or approval of the products which are sold by Direct Tools, with the trademark TERMINATOR hand printed on the packaging for gloves which are not TERMINATOR gloves, thereby causing Banom immediate and irreparable injury for which it has no adequate remedy at law.

COUNT IV

COPYRIGHT INFRINGEMENT

31. The copying and displaying of Banom's copyrighted photograph of its TERMINATOR gloves by Direct Tools, without a license or authorization by Banom, constitutes an act of copyright infringement under 17 U.S.C. § 501.

32. Knowing it had no right to copy and display Banom's copyrighted photograph, the copyright infringement by Direct Tools was willful.

WHEREFORE, Plaintiff prays that:

1. The Court enter judgment that:

- (a) Direct Tools has infringed on Banom's registered trademark TERMINATOR, in violation of 15 U.S.C. § 1114(1);
- (b) Direct Tools has competed unfairly with Banom in its use of photographs and the trademark TERMINATOR to palm off the products of another manufacturer as being those of Banom;
- (c) Direct Tools has engaged in a false designation of origin under 15 U.S.C. § 1125(a);
- (d) Direct Tools infringed on the copyright of Banom in the photograph of the TERMINATOR gloves; and,
- (e) the copyright infringement by Direct Tools was willful.

2. Direct Tools and its agents, employees, servants, attorneys, successors and assigns, and all others in privity or acting in concert therewith, be preliminarily enjoined, and thereafter permanently enjoined, from:

- (a) using the trademark TERMINATOR, or any other trademark, trade name, service mark, corporate or other commercial designation which is a colorable imitation of Banom's trademark TERMINATOR and is likely to be confused therewith;
- (b) competing unfairly with Banom, in the manner complained of herein;
- (c) engaging in any false designation of origin with respect to Banom and its trademark, in the manner complained of herein; and,
- (d) infringing on Banom's copyright covered by Copyright Certificate of Registration No. TX 7-273-448.

3. Pursuant to 15 U.S.C. § 1117, Direct Tools be directed to pay to Banom compensatory damages in an amount to be determined at trial for the injury sustained by Banom in consequence of the acts complained of herein, and that such damages be trebled because of the willful acts of trademark infringement and unfair competition described herein.

4. Pursuant to 15 U.S.C. § 1117, Direct Tools be required in equity to account for and pay to Banom all profits realized by Direct Tools as a result of its use of an infringing trademark, as a result of its engaging in unfair competition and as a result of its engaging in a false designation of origin.

5. Direct Tools be required to pay to Banom the costs of this action, and in accordance with 15 U.S.C. § 1117(a), the reasonable attorneys' fees incurred by Banom.

6. Direct Tools be required to pay prejudgment interest, pursuant to 15 U.S.C. § 1117(b).

7. Direct Tools be required to pay maximum statutory copyright damages, pursuant to 17 U.S.C. § 504(c), in view of the willful nature of the copyright infringement.

8. Direct Tools be required to pay costs, including reasonable attorneys' fees, for copyright infringement, pursuant to 17 U.S.C. § 505.

9. Banom be granted such other and further relief as the Court deems equitable and proper.

JURY DEMAND

Plaintiff, Banom, hereby demands a trial by jury on any and all issues so triable.

Respectfully submitted,

January 13, 2017



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Attorneys for Plaintiff



## **EXHIBIT A**

**Int. Cl.: 9**

**Prior U.S. Cls.: 21, 23, 26, 36, and 38**

**Reg. No. 2,748,280**

**United States Patent and Trademark Office**

**Registered Aug. 5, 2003**

**TRADEMARK  
PRINCIPAL REGISTER**

**TERMINATOR**

COMMODITY GLOVE COMPANY, INC. (PENN-  
SYLVANIA CORPORATION)  
P.O. BOX 687  
WAYNE, PA 19087

FIRST USE 6-27-2002; IN COMMERCE 6-27-2002.

SN 76-314,626, FILED 9-19-2001.

FOR: CUT-RESISTANT GLOVES FOR INDUS-  
TRIAL USE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36  
AND 38).

KIM SAITO, EXAMINING ATTORNEY

## **EXHIBIT B**



**BOSCH**



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### Terminator Cut Resistant Glove-Size 9



Code: **TERMGLOVE9**

Price: **\$14.95**

Shipping Weight: **0.50 pounds**

Quantity in Basket: *None*

#### Banom Terminator® Cut Resistant Gloves

MaxPly® Dyneema® Seamless Knit Liner with an All-Grip® Palm Coating - CPPT - 565, EN388 - Level 3.

Knit with MaxPly® Dyneema®, Terminator® gloves are cool and comfortable to wear.

These cut rgloves have proven to be safe, durable, and cost effective in sheet metal and electrical assembly operations where dexterity is required.

The special palm coating provides a good grip in oily, wet or dry applications.

With ten sizes available, workers can get an exact fit in order to do their job safely without removing their gloves.

These gloves come in sizes: 5-12

Quantity:

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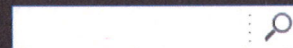
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### Terminator Gloves

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[Terminator Cut Resistant Glove-Size 9](#)

Code: **TERMGLOVE9**

Price: **\$14.95**

Quantity in Basket: none

Add To Basket



[Terminator Cut Resistant Glove-Size 8](#)

Code: **TERMGLOVE8**

Price: **\$14.95**

Quantity in Basket: none

Add To Basket



[Terminator Cut Resistant Glove-Size 10](#)

Code: **TERMGLOVE10**

Price: **\$14.95**

Quantity in Basket: none

Add To Basket



[Terminator Cut Resistant Glove-Size 11](#)

11

Code: **TERMGLOVE11**

Price: **\$14.95**

Quantity in Basket: none

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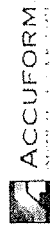
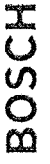
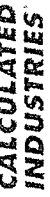
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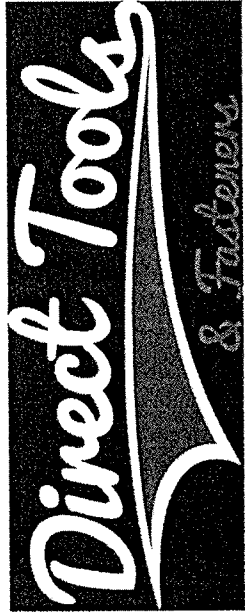


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Order #1896

Thank you for your order. Please keep this invoice for your records.

Date: 12/29/2016 09:47:01 EST

Ship To:

Name: [REDACTED]  
Email Address: [REDACTED]  
Phone Number: [REDACTED]  
Fax Number: [REDACTED]  
Company: [REDACTED]  
Address: [REDACTED]

Wayne, PA 19087  
US

Bill To:

Name: [REDACTED]  
Email Address: [REDACTED]  
Phone Number: [REDACTED]  
Fax Number: [REDACTED]  
Company: [REDACTED]  
Address: [REDACTED]

Wayne, PA 19087  
US

Item

Terminator Cut Resistant Glove-Size 9 -  
TERMGLOVE9

Qty.	Item Price	Total Price
6	\$14.95	\$89.70
Shipping: FedEx Home Delivery®:		\$14.83
Sales Tax:		\$0.00
Total:		\$104.53

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## **EXHIBIT E**







## **EXHIBIT F**